

Amendments to the Drawings:

The attached Replacement Sheet replaces original Sheet 1 (Corresponding to Fig. 1). Reference numeral 153 has been added to Fig. 1. Support for the amendment is provided in the Specification at, at least, page 5, line 6 of the originally-filed Specification. Applicants respectfully submit no new matter is included with the submission. The Replacement Sheet has been prepared based on the original drawings and in compliance with 37 C.F.R. §§ 1.84 and 1.121.

Attachment: 1 Replacement Sheet

Remarks

Claims 16, 18-20 and 24-34 are pending. Claims 16, 18-20 and 24-34 are objected to by the Examiner because of several informalities. Claims 16, 18-20 and 24-34 are rejected under 35 U.S.C. § 103(a).

The Specification has been amended to correct typographical errors. No new matter has been added as a result of the amendments. Fig. 1 has been amended to include the reference numeral 153. Support for the amendment is provided in the Specification at, at least, page 5, line 6 of the originally-filed Specification. Applicants respectfully submit no new matter is included with the submission.

Claims 32-34 have been cancelled without prejudice. Claims 16, 18-20, and 24-28 have been amended to correct typographical errors and to clarify the claims. Support for the amendments can be found, at least at, page 2, lines 27-28; page 4, lines 32 through page 4, line 3; page 6, lines 33-37; page 7, lines 11-14.

For the reasons stated below, Applicant respectfully requests reconsideration and withdrawal of the rejections to the claims.

1. OBJECTION TO CLAIMS 16, 18-20, 24-28 AND 33

Claim 16 stands objected to because the phrase “a electromagnetic” should read “an electromagnetic.” Claim 16 has been amended to correct this typographical error.

Claims 18-20, 24-28 and 30-31 stand objected to because the phrase “The arrangement” lacks sufficient antecedent basis. Claims 18-20, 24-28 and 30-31 have been amended by replacing the word “arrangement” with the word “system” as used in independent claim 16.

Claim 20 stands objected to because “said amplifier” and “said processor” and “said “data storing arrangement” lack sufficient antecedent basis. Claims 20 has been amended to properly depend from claim 19.

Claim 20 stands objected to because the word “analysed” should be “analyzed.” Claim 20 has been amended to correct this typographical error and the word “analyser” has been amended to read “analyzer.”

Claim 24 stands objected to because “said detectable part” lacks sufficient antecedent basis. Claim 24 has been amended to replace the word “detectable” with the word “magnetic” as per the previous amendment to claim 16.

In addition, claim 29 has been amended to correct a typographical error such that “contactless” now reads “contactlessly.”

Applicants submit no new matter has been added as a result of the amendments.

2. DOUBLE PATENTING

Claims 29 and 32-34 are provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as that of claims 22-25, respectively, of copending Application No. 12/393,931. Because this is a provisional rejection at this time, Applicants are not required to submit a terminal disclaimer at this time. Applicants will file a suitable terminal disclaimer at a later date if appropriate.

3. REJECTION OF CLAIMS UNDER 35 U.S.C. § 103(a)

Claims 16, 18-20 and 25-34 stand rejected under 35 U.S.C. § 103(a)

Claims 16, 18-20 and 25-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,392,779 to Meredith et al. (“Meredith”) in view of U.S. Patent No. 6,161,046 by Maniglia et al. (“Maniglia”). For a rejection to be proper under 35 U.S.C. § 103(a), the cited references, either alone or in combination, must teach or suggest every element of the claimed invention. For the reasons stated below, Applicant respectfully submits that neither Meredith nor Maniglia, either alone or in combination, teach or suggest every element of Applicant’s claimed invention.

Regarding claims 16, 18-20, 25-28 and 30-31

Claim 16 recites, in part:

“a member adapted to be releasably attached to said implant,”

“detecting means for detecting at least one resonance frequency of the member when it is attached to the implant,” and

“wherein said member comprises a magnetic part and said detecting means comprises an electromagnetic detector for contactless detection of said magnetic part.”

The Office action states that Meredith fails to disclose a “member comprising a magnetic part or a coil; or a detector comprising an electromagnetic part or a magnetic part.” (See, Office action, page 6, last ¶). Applicants respectfully submit that Meredith also fails to disclose, at least, an electromagnetic detector for contactless detection of said magnetic part.

The Office action states Maniglia teaches a “disposable implant member 36’ comprising a magnetic detectable part having a (titanium) coil releasably connected to a bone 24’; and a probe portion comprising an electromagnetic detector (i.e., coil) (see fig. 4; col. 5, lines 45-49; col. 6, lines 8-10, 13-16 & 51-57.” Applicants respectfully submit Maniglia does not teach the claimed elements of Applicants’ invention. Maniglia teaches (and the components identified in the Office action are components of) a microphone, which is not similar to the detecting means of Applicants’ claimed invention. (See, “The cardrum and malleus magnet assembly and electromagnetic coil act as a microphone in a reverse cycle as compared with device described for partial hearing loss,” Maniglia, col. 5, lines 30-33).

Further, the microphone components of Maniglia are configured and intended to receive acoustic signals for improvement of hearing loss, whereas Applicants member and detecting means detect structural resonances to test an implant attached to a bone. Meredith and Maniglia are directed to two different applications. Neither Meredith nor Maniglia teach or suggest that a microphone could be used for such purposes. Applicants submit it would not have been obvious to one of ordinary skill in the art to combine the teachings of Meredith and Maniglia. Applicants also submit the two references do not teach or suggest how the elements of Meredith could be combined with the elements of Maniglia to achieve the desired result. Accordingly, Applicants respectfully submit neither Meredith nor Maniglia, either alone or in combination, teach or suggest every element of Applicant’s claimed invention.

In addition, contrary to the argument presented in the Office action, Maniglia does not teach or suggest “a disposable implant member.” Maniglia does not use the term “disposable.”

For, at least, the reasons stated above, Applicants submit that claim 16 is in condition for allowance. Claims 18-20, 25-28, and 30-31 depend, directly or indirectly, from claim 16. For the same reasons as stated above with respect to claim 16, Applicants submit claims 18-20, 25-28, and 30-31 also are in condition for allowance.

Regarding claim 29

Claim 29 recites:

“A disposable implant testing part provided for testing an implant attached to a bone, said part comprising a detectable part, which can be detected contactless by means of a detector.”

Applicants submit neither Meredith nor Maniglia teach or suggest the elements of claim 29 for the same reasons described above with respect to claim 16. Accordingly, Applicants submit that claim 29 is in condition for allowance.

Claim 24 stands rejected under 35 U.S.C. § 103(a)

Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meredith in view of Maniglia, and further in view of U.S. Patent No. 6,583,630 to Mendes et al. (“Mendes”). For a rejection to be proper under 35 U.S.C. § 103(a), the cited references, either alone or in combination, must teach or suggest every element of the claimed invention. For the reasons stated below, Applicant respectfully submits that Meredith, Maniglia and Mendes, neither alone or in combination, teach nor suggest every element of Applicant’s claimed invention.

The Office action states that Mendes describes a detectable part that consists of ferromagnetic material. Applicants submit that Mendes does not cure the deficiencies of Meredith and Maniglia. Applicants submit that Mendes does not teach or suggest, at least the following limitations of claim 16:

“a member adapted to be releasably attached to said implant,”

“detecting means for detecting at least one resonance frequency of the member when it is attached to the implant,” and

“wherein said member comprises a magnetic part and said detecting means comprises an electromagnetic detector for contactless detection of said magnetic part.”

For the reasons stated above, Applicants submit claim 24 is in condition for allowance.

CONCLUSION

Applicant’s discussion of particular positions of the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicant. Applicant’s emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable nor does it imply the claims were not allowable in their unamended form.

In view of the foregoing remarks, Applicants respectfully submit that all claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the Examiner feels that a telephone conference would expedite the prosecution of this case, the Examiner is invited to call the undersigned.

If any fees are due with the submission of this Amendment and Response, the Commissioner is hereby authorized to charge the fees due to Attorney’s Deposit Account No. 50-4514.

Respectfully submitted,

By /s Erik Saarmaa/
Erik Saarmaa

Dated: October 18, 2010

Telephone: (857) 277-6900
Facsimile: (617) 426-2321

Registration No. 56,834
Pierce Atwood LLP
160 Federal Street, 10th Floor
Boston, MA 02110